

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Baker

Atty. Docket No.: BBA-10002/29

Serial No.: 10/821,766

Group No.: 3676

Filed: April 9, 2004

Examiner: Mark A. Williams

For: ERGONOMIC HANDLES, ESPECIALLY FOR GARDEN TOOLS

APPELLANT'S CORRECTED APPEAL BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief dated April 9, 2007, Appellant hereby submits it corrected appeal brief.

I. Real Party in Interest

The real party and interest in this case is Bruce Baker, Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 12 claims. Claims 13-19 were added by amendment in December 2004. Claims 20-31 were added by amendment in July 2005. Claims 1-19 and 26-29 have been canceled. Claims 20-25, 30 and 31 are rejected, pending and under appeal. Claim 20 is the sole independent claim.

IV. Status of Amendments Filed Subsequent Final Rejection

An after-final amendment is being submitted herewith changing “users” to “user’s” in claim 31.

V. Summary of Claimed Subject Matter

Independent claim 20 is directed to a hand tool 104, comprising a curved trowel blade 104 having a lower surface tangent to a plane and a handle 102 attached to the blade. The handle is curved in a plane perpendicular to the plane tangent to the blade (Figure 3). The handle further includes an outer surface defining a portion of a circular arc (Figure 1). The handle terminates in a gripping section that intersects and extends beyond the plane tangent to the blade. (Specification page 5, line 21 to page 7, line 11; Figures 1-3)

Dependant claim 31 adds to claim 20 that the blade defines a primary line of attack, such that the gripping section 102 allows a user to hold the tool in a wrist-neutral position with a user’s forearm aligned along the line of attack 110. (Specification page 5, line 5 to page 7, line 14; Figures 1-3)

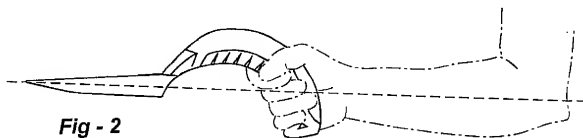
VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

1. The rejection of claims 20 and 21 under 35 U.S.C. §102(b) as being anticipated by U.S. Design Patent No. D305,496 to Jasperson, wherein claim 21 stands or falls with claim 20.
2. The rejection of claim 31 under 35 U.S.C. §102(b) as being anticipated by U.S. Design Patent No. D305,496 to Jasperson.
3. The rejection of claims 22 and 23 under 35 U.S.C. §103(a) as being obvious over U.S. Design Patent No. D305,496 to Jasperson.
4. The rejection of claims 24 and 25 under 35 U.S.C. §103(a) as being obvious over U.S. Design Patent No. D305,496 to Jasperson.
5. The rejection of claim 30 under 35 U.S.C. §103(a) as being obvious over U.S. Design Patent No. D305,496 to Jasperson.

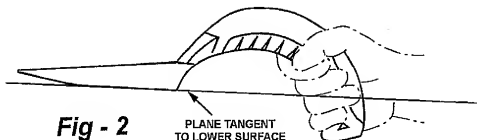
VII. Argument

- A. The rejection of claims 20 and 21 under 35 U.S.C. §102(b) over U.S. Design Patent No. D305,496 to Jasperson, wherein claim 21 stands or falls with claim 20.

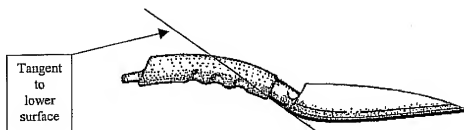
Claim 20 includes, among other limitations, a curved trowel blade having a lower surface tangent to a plane and a handle that terminates in a gripping section that intersects and extends beyond the plane tangent to the blade. This configuration allows a user to hold the tool in a wrist-neutral position, with a user's forearm aligned along the primary line of attack, depicted as a broken line in Figure 2 of the application, reproduced below:



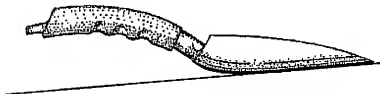
To illustrate the limitation of “a lower surface tangent to a plane and a handle that terminates in a gripping section that intersects and extends beyond the plane tangent to the blade,” Appellant draws a line as follows:



This is the only *reasonable* interpretation of this limitation. The Examiner rejected the claim, however, under 35 U.S.C. §102(b) as being anticipated by U.S. Design Patent No. D305,496 to Jasperson, entitled “Garden Trowel.” In an effort to legitimize this rejection, the Examiner drew a line “tangent to lower surface” of the implement of Jasperson as follows:



This interpretation is arbitrary and contrary to common sense. Using this unconventional interpretation, the Examiner argues that the gripping section of Jasperson intersects and extends beyond the plane tangent to the blade. The *reasonable* person, however, would draw the tangent in the case of Jasperson as follows, thereby precluding anticipation, because the gripping section of Jasperson does NOT "intersect and extend beyond the plane tangent to the blade."



While Appellant is fully cognizant that during patent examination pending claims can—and, indeed, should—be given their broadest reasonable interpretation, in this case, the Examiner's interpretation is entirely unreasonable. Appellant's position is supported by the fact that if the Examiner had simply used another Figure of Jasperson—Figure 5, for example—the handle never comes near a plane tangent to the "lower surface:"



To be consistent, the Examiner must be able to draw his proposed line on *every view* of the cited reference. This is impossible because the Examiner's interpretation of Appellant's claim language is unorthodox. [T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." Phillips v. AWH Corp., 415 F.3d 1301 (Fed. Cir. 2005), 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*); Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) ("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. Ferguson Beauregard/Logic Controls v. Mega Systems, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003).

Thus, the broadest reasonable interpretation must be consistent with the interpretation *that those skilled in the art would reach*. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). To the person of ordinary skill in *elementary geometry*, a plane tangent to the lower surface of any object is just that: *tangent to the lower surface*. Any reasonable person would first look at the bottom of the object to see if there is a lower surface and, if so, draw the line tangent to that surface. The skilled artisan would not arbitrarily travel up the side of the object and say that some arbitrary point

is tangent to some arbitrary plane. Indeed, the Examiner's proposed line not only fails to be tangent to a "lower surface," it appears to tangent to a point on the handle and not on the blade.

Claim interpretation must also be consistent with the specification." In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The written description must be examined in every case, because it is relevant not only to aid in the claim construction analysis, but also to determine if the presumption of ordinary and customary meaning is rebutted. See Remishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998). The presumption will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth a definition of the term different from its ordinary and customary meaning. See In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992). The presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope. See Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1324, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002)

Consistency with the specification is important in this case, because the limitation of "a lower surface tangent to a plane and a handle that terminates in a gripping section that intersects and extends beyond the plane tangent to the blade" allows a user to hold the tool in a wrist-neutral position, with a user's forearm aligned along the primary line of attack, as shown in Appellant's drawing above. The tool of Jasperson is conventional. The handle is nearly straight. As such, a user would have to grip it in a conventional manner, with a bent wrist outside the wrist-neutral position.

B. The rejection of claim 31 under 35 U.S.C. §102(b) as being anticipated by U.S. Design Patent No. D305,496 to Jasperson.

Claim 31 also stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Design Patent No. D305,496 to Jasperson. Regarding this limitation, the Examiner's only "argument" is that "the device [of Jasperson] is capable of performing as claimed." This is not true. The handle of Jasperson can only be held with a bent wrist, creating the very problem that Appellant's design avoids. This is not sufficient under section 102 of the statute. Although a prior art device may be capable of performing the way the apparatus is claimed, there must be a suggestion or motivation in the reference

to do so. In re Mills, 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). At the very least, the Examiner should articulate where, in the prior art, one would find the suggestion or motivation in support of the conclusion that the reference is “fully capable of” a particular function of interest. After all, the cited reference *is a design patent*, with no claimed functionality whatsoever.

That a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) Given the design of Jasperson, it does not follow that “the device is capable of [allowing a user to hold the tool in a wrist-neutral position with a users forearm aligned along the line of attack].”

C. The rejection of claims 22 and 23 under 35 U.S.C. §103(a) as being obvious over U.S. Design Patent No. D305,496 to Jasperson.

Claims 22 and 23 stand rejected over Jasperson on the grounds that discovering the optimum or workable ranges involves only routine skill in the art, citing In re Aller, 105 USPQ 233. “Such modifications are not critical to the design and would have produced no unexpected results. One reason for making such modification may be for optimizing comfort of the gripping surface for the average user.” Appellant respectfully disagrees. First, there is no teaching or suggestion from the reference that the use of Appellant’s dimensions would “optimize the comfort of the gripping surface.” The article shown in the ‘496 patent appears perfectly comfortable, and certainly the inventor thereof had the

opportunity to “optimize the comfort of the gripping surface” if the need arose. Second, Appellant did achieve an unexpected result—namely, the ability to use the tool in a wrist-neutral position. Such a result goes well beyond mere “comfort.”

D. The rejection of claims 24 and 25 under 35 U.S.C. §103(a) as being obvious over U.S. Design Patent No. D305,496 to Jasperson.

Claims 24 and 25 stand rejected over Jasperson on the grounds that it is an obvious manner of design choice to make different portions of the device “whatever form or shape was desired,” citing In re Dailey et al., 149 USPQ 47. Appellant respectfully disagrees. First, there is no teaching or suggestion from the reference that the use of Appellant’s dimensions would “optimize the comfort of the gripping surface.” The article shown in the ‘496 patent appears perfectly comfortable, and certainly the inventor thereof had the opportunity to “optimize the comfort of the gripping surface” if the need arose. Second, Appellant did achieve an unexpected result—namely, the ability to use the tool in a wrist-neutral position. Such a result goes well beyond mere “comfort.”

E. The rejection of claim 30 under 35 U.S.C. §103(a) as being obvious over U.S. Design Patent No. D305,496 to Jasperson.

Claim 30 stands rejected over “Official Notice.” While conceding that Jasperson does not disclose a polymeric covering, the Examiner argues that it would be obvious to do so. First, it appears to Appellant that the Examiner is relying entirely on Official Notice, since Jasperson does not teach the claim limitation. Second, Since this claim carries with it all of the limitations of the claim from which it depends, and since Jasperson does not teach or suggest all of the limitations in combination, *prima facie* obviousness has not been established.

Conclusion

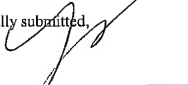
In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board’s concurrence at this time.

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Respectfully submitted,



By: _____

Date: May 9, 2007

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APPENDIX A

CLAIMS ON APPEAL

20. A hand tool, comprising:
a curved trowel blade having a lower surface tangent to a plane;
a handle attached to the blade, the handle being curved in a plane perpendicular to the plane tangent to the blade;
the handle including an outer surface defining a portion of a circular arc; and
wherein the handle terminates in a gripping section that intersects and extends beyond the plane tangent to the blade.
21. The hand tool of claim 20, wherein the circular arc has a center below the plane tangent to the blade.
22. The hand tool of claim 20, wherein the circular arc has a radius on the order of 3 to 4 inches.
23. The hand tool of claim 20, wherein the gripping section has a cross-sectional circumference in range from 3.5 to 5 inches.
24. The hand tool of claim 20, wherein the gripping section includes a slight taper along its length.
25. The hand tool of claim 20, wherein at least a portion of the gripping portion forms a flattened ellipsis in cross section.
30. The hand tool of claim 20, wherein the handle includes a polymeric covering.
31. The hand tool of claim 20, wherein:

the blade defines a primary line of attack; and

the gripping section allows a user to hold the tool in a wrist-neutral position with a user's forearm aligned along the line of attack.

APPENDIX B

EVIDENCE

None.

APPENDIX C
RELATED PROCEEDINGS

None.